

212/510

Remarks

Claims 1 through 6 remain pending in the application. An RCE is filed. We request this response be entered and the response dated August 30, 2005 subject to the advisory action not be entered.

Claim Rejections - 35 U.S.C. §103 (Chu)

The Office Action rejects claim 1, 5 and 6 as obvious over Chu et al., Method and Apparatus for Severing and Capturing Polyps, U.S. Patent 6,010,512 (Jan. 4, 2000). The Office Action Asserts Chu discloses the system and method claimed by the Applicant, but fails to disclose a heating element. Further, the Office asserts it would have been obvious to modify Chu by incorporating a heating element along the snare cable which would be tantamount to the Applicant's claimed invention. The Office Action asserts the motivation to one of ordinary skill is to provide the added benefit of cauterizing along the snare cable providing a cleaner cut and detachment of the polyp. The Applicant respectfully traverses the rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and

212/510

not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Applicant's limitations in Claim 1, 5 and 6 include, *inter alia*, a heating element disposed on at least one of the jaws. Chu fails to disclose or suggest a heating element disposed on at least one of the jaws. The Office Action has misapprehended Applicant's invention. Unlike Chu, the Applicant does not deliver energy along the snare cable. Instead, Applicant uses the cable to snare the polyp and draw the jaws closed. The Applicant's snare cable is not used to cut the polyp. A separate heating element on the jaw is used to sever the polyp from the body. Thus, adding a heating element to the cable shown in Chu would not result in Applicant's invention and would not result in the claimed devices. Accordingly, claims 1 through 6 are non-obvious.

In addition, the Office Action does not provide the required motivation to modify Chu. Outdated maxims, such as whether one skilled in the art would be empowered with an idea, do not meet the legally required obviousness analysis. Moreover, there is nothing in Chu that would motivate one of ordinary skill in the art to meet all of the limitations of the claims.

The Office Action states that the proposed modification to Chu would provide the added benefit of cauterizing tissue along the Chu snare cable to more cleanly cut and detach a polyp. Since Applicant does not use a cable to cut a polyp, this statement cannot serve as a motivation to modify Chu. Furthermore, no such motivation exists in Chu or in any other

212/510

known reference. Since there is no motivation to modify Chu, claims 1 through 6 are non-obvious.

The Office Action further asserts that disposing a heating element on at least one of the jaws is obvious over Chu in view of Fleury, Jr., Surgical Snare, U.S. Patent 4,326,530 (Apr. 27, 1982). Fleury, however, does not disclose disposing a heating element on a jaw. Fleury uses a snare of conductive material as a heating element. (col. 2, line 41-61). Fluery only teaches use of a snare as a heating element which is consistent with Chu's use of the snare as heating element. This, however, is not consistent with the Applicant's claimed invention. The applicant disposes a separate heating element on the jaw. Indeed, the prior art cited by the Office Action fails to teach, suggest or disclose a separate heating element on the jaw of a device which is the stated reasons for allowance made by this very Examiner in his Reason for Allowance dated April 17, 2003 in Applicant's parent application 09/916,356, now U.S. Patent 6,010,512

Since Chu and Fluery, both singularly and in combination, fail to disclose, teach or suggest several claim limitations found in the Applicant's claimed invention, they do not render obvious the Applicant's claimed invention. Therefore, withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 U.S.C. §103 (Chu & Stati)

The Office Action rejects claim 4 as obvious over Chu et al., Method and Apparatus for Severing and Capturing Polyps, U.S. Patent 6,010,512 (Jan. 4, 2000) in view of Stati et al., Method of Inhibiting Blood Clot on Silicone Rubber Medical Devices,

212/510

U.S. Patent 3,829,903 (Aug. 20, 1974). The Applicant respectfully traverses this rejection.

Stati is directed towards a method of inhibiting blood clots on the surface of silicone rubber medical devices. Stati fails disclose a heating element disposed on at least one of the jaws. Chu also fails to disclose a heating element disposed on at least one of the jaws as previously discussed.

Since Chu and Stati each fail to teach, suggest or disclose at least one common limitation recited in claim 4, it follows that the combination of both references fails to teach, suggest or disclose the invention recited in claim 4. As such, claim 4 is patentable over Chu in view of Stati. For at least these reasons, withdrawal of this rejection is respectfully requested.

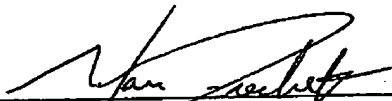
212/510

Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

Date: November 9, 2005

By:


Marc J. Frechette, Esq.
Reg. No. 49060